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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,835	02/26/2002	Ralf Otto	H 4148 PCT/US	4730

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COGNIS CORPORATION  
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EXAMINER

HENRY, MICHAEL C

ART UNIT PAPER NUMBER

1623

DATE MAILED: 12/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/856,835

Applicant(s)

OTTO ET AL.

Examiner

Michael C. Henry

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1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____.                                   |

### **DETAILED ACTION**

Claims 12-23 are pending in application

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

The information disclosure statement filed complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file and the information referred to therein has been considered as to the merits.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the phrase, "like an ester ". However, this phrase renders the claim confusing, vague and indefinite. More specifically, "like an ester" implies other chemical groups.

Claim 19, recites the limitation "R<sup>5</sup>" in the formula R<sup>3</sup>COOR<sup>5</sup>. However, "R<sup>5</sup>" lacks antecedent basis, since it was not reference or defined any where in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-17 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Keapigu et al. (Zhongguo Yaoke Daxue Xuebao (1996), 27(5), 271-273).

In claim 12, applicants claim “a salicyl alcohol derivative of the formula (I):  $R^1-OCH_2-Ph-O-Z-(R^2)_n$  .....”. Keapigu et al. disclose applicants’ claimed salicyl alcohol derivative of the formula (I):  $R^1-OCH_2-Ph-O-Z-(R^2)_n$  (see abstract). He refers to this salicyl alcohol derivative as .beta.-D-Glucopyranoside, 2-(hydroxymethyl) phenyl, 6-[3-(4-hydroxyphenyl)-2-propenoate]. In claim 13, applicants claim “a salicyl alcohol derivative of claim 12, wherein at least one of the two substituents  $R^1$  and  $R^2$  is a ..... p-hydroxy-3-phenylacryloyl.....” Keapigu et al. disclose applicants’ salicyl alcohol derivative of claim 12, wherein at least one of the two substituents  $R^1$  and  $R^2$  is a p-hydroxy-3-phenylacryloyl. It should be noted that claims 17 and 23 are also encompassed by this rejection.

***Allowable Subject Matter***

The following is an examiner’s statement of reasons for allowance: The examiner has found claims 18-22 to be unobvious over the prior art of record and therefore to be allowable over the prior art of record, only if the 112 rejections are overcome.

The present invention relates to salicyl alcohol derivatives and a process for their production

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The most relevant prior art document (Otto et al., Journal of Biotechnology 64 (1998) 231-237) to this invention discloses similar salicyl alcohol derivatives and a process for their production.

However, though the compounds of the present invention are salicyl alcohol derivatives to those claimed in the prior art document, they possess structural differences that are unobvious to those of the prior art. In addition, applicants' process is unobvious to those of the prior art especially those involving enzymes-catalyzed esterifications or transesterifications.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 703 308-7307. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703 308-4624. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

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MCH

November 27, 2002

  
SAMUEL BARTS  
PRIMARY EXAMINER  
GROUP 1200